

### **REMARKS**

In the Official Action, the Examiner asserted that Claims 1, 2, 4 to 10, 13, and 15 to 46 were pending in the subject patent application.

The Applicant points out that Claim 29 was cancelled in the Applicant's Amendment filed May 19, 2006 (see also claims identified by Examiner in Notice of Allowance, mailed July 11, 2006; and in Applicant's Amendment After Allowance filed October 11, 2006). Therefore, Claims 1, 2, 4 to 10, 13, 15 to 28, and 30 to 46 are presently pending in the subject patent application. The Applicant has reproduced the pending claims for convenience of reference.

In the Official Action, the Examiner raised an objection to the subject patent application for allegedly being directed to a plurality of distinct inventions, contrary to 35 USC 121.

The Examiner identified the following three inventions:

- I. Claims 1, 2, 4 to 10, 13, 15 to 22, and 27 to 45: directed to a modular spa.
- II. Claims 23 to 26: directed to a method of fabricating a spa shell
- III. Claim 46: directed to a method of assembling a spa

The Applicant disagrees with the restriction, and provisionally elects Claims 1, 2, 4 to 10, 13, 15 to 22, 27, 28, and 30 to 45, with traverse.

§803 MPEP states that if the search and examination of all the claims in an application can be made without serious burden, the Examiner must examine them on the merits, even though they include claims to independent or distinct inventions. The Examiner asserted that for one or more of the following reasons, examination of all the pending claims could not be made without serious burden on the Examiner:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

- (c) the inventions require a different field of search;
- (d) the prior art applicable to one invention would not likely be applicable to another invention; and
- (e) the inventions are likely to raise different non-prior art issues under 35 USC 101 and/or 35 USC 112, second paragraph.

The Applicant disputes that examination of all of the pending claims in the subject patent application would impose a serious burden on the Examiner. The Applicant refers the Examiner to 37 CFR 1.104(a)(1) which requires the Examiner to conduct a complete prior art search and a thorough examination of the pending claims:

37 CFR 1.104(a)(1). On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

Further, §803 MPEP does not contemplate the issuance of a restriction requirement if the search and examination of all the claims in an application would impose a simple burden on the Examiner, but instead only allows the Examiner to issue a restriction requirement if the search and examination would impose a serious burden.

The Applicant points out that, on January 17, 2006 and again on July 5, 2006, the Examiner conducted prior art searches of claims that are identical (except for a typographical error) to the claims that are currently pending in the subject patent application. The Examiner issued a Notice of Allowance for these claims on July 11, 2006. The Applicant filed the instant Request for Continued Examination only to correct the typographical error, and because the Examiner did not consider the references that the Applicant had properly filed in its Information Disclosure Statement pursuant to 37 CFR 1.97 (c). Since the relevant date for the determination of anticipation and obviousness did not change subsequent to the prior art searches conducted by the Examiner, the Applicant respectfully submits that, unless the Examiner can demonstrate that the previous prior art searches did not comply with the completeness requirements of 37 CFR 1.104(a)(1) and 37 CFR 1.104(c), the Examiner has no basis for conducting any further searches

for these already searched, examined and allowed claims and, therefore, has no basis for arguing that all of the Claims groups in subject patent application could not be searched and examined in the subject patent application without imposing a serious burden on the Examiner.

The Applicant also refers the Examiner to §704.01 MPEP, which is reproduced below:

§704.01 Search

PREVIOUS EXAMINER'S SEARCH

When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general the second examiner should not take an entirely new approach to the application or attempt to reorient the point of view of the previous examiner, or make a new search in the mere hope of finding something.

Although this paragraph obviously relates to prior art searches conducted by a different examiner, the Applicant respectfully submits that, at least in this circumstances of the subject patent application, the Examiner is compelled to give full faith and credit to his own prior searches as if those searches had been conducted by a different examiner. For all of the foregoing reasons, the Applicant submits that the requirement to search and examine all of the Claims groups in the subject patent application would not impose a serious burden on the Examiner.

The Applicant notes that 37 CFR 1.142(a) allows a restriction requirement to be issued at any stage of prosecution up to final action and, therefore, a second requirement may be made even though, as in the subject patent application, there has already been a prior restriction requirement with which applicant complied. However, the Applicant points out that 37 CFR 1.142(a) only allows a subsequent restriction requirement to be issued when such restriction is proper (see §811.02 MPEP). Since the requirement to search and examine all of the Claims groups in the subject patent application would not impose a serious burden on the Examiner, the Applicant submits that this second restriction requirement is contrary to 37 CFR 1.142(a).

Application No. 10/742,892  
Amendment dated April 25, 2008  
Response to Official Action of March 27, 2008

Therefore, the Applicant respectfully requests the Examiner to reconsider this new restriction requirement.

Respectfully submitted,  
HEENAN BLAIKIE LLP

By 

Robert Graham  
Reg. No. 43,430  
Tel: 416-360-3524

hbdocs - 2414946v1